

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1901.

CLARENCE M. BUSCH, Appellant,

vs.

JOSHUA W. JONES and THE W. O. HICKOK
MANUFACTURING COMPANY, Appellees.

No. 96.

This appeal is brought here from a decision of the Court of Appeals for the District of Columbia affirming the decree of the Supreme Court of the District of Columbia in a suit brought by Joshua W. Jones and The W. O. Hickok Manufacturing Company against Clarence M. Busch, the appellant in this case.

The case was originally brought in the Supreme Court of the District of Columbia March, 1894, against Clarence M. Busch, a resident of the District of Columbia, for the use of a machine purchased from the manufacturer, The Seybold Machine Company, of Dayton, Ohio, which machine was used by the said Busch at Harrisburg, Pa., the said Busch being at the time the suit was brought the State Printer for the State of Pennsylvania.

The suit was brought by Jones, the patentee, and his exclusive licensee, The W. O. Hickok Manufacturing Company, upon two letters patent of the United States, the one dated June 11, 1878, which expired June 11, 1895, one year and three months after the suit was filed, and no motion for preliminary injunction had been made prior to the interlocutory decree, which was January 30, 1896 (R. pages 145, 146), more than eight months after the patent of June 11, 1878, had expired; and also upon letters patent dated the 26th day of May, 1891, granted to Jones and assigned to The W. O. Hickok Manufacturing Company, as alleged in the bill of complaint, prior to the time said patent was granted, but while the application for said patent was pending in the United States Patent Office, the application for said letters patent of May, 1891, having been filed July 26, 1889, and

the contract between Jones and The W. O. Hickok Manufacturing Company having been executed the 27th day of December, 1889 (R. p. 96).

Profert of this agreement, which was recorded in the United States Patent Office, was made in the bill of complaint, and by reference to this agreement, it appears that it gave an exclusive license to The Hickok Manufacturing Company under both of the patents in suit, six other patents and other applications then pending for improvements upon the inventions described in the first patent of June 11, 1878. By the terms of this agreement all the patents and processes of Jones, of whatever character, whether in patents already granted, in applications pending or in other improvements relating to the same subject matter, were assigned absolutely to The W. O. Hickok Manufacturing Company by Jones as the patentee, reserving only to Jones a royalty of 25 per cent. on the machines manufactured by The W. O. Hickok Manufacturing Company. There was no reservation whatever to Jones for any other royalty for his machines or for his process, excepting the 25 per cent. of the selling price of the machine at the time the contract was made.

Complainants closed their testimony July 27, 1895 (R. page 89), after the patent of June 11, 1878, had expired, and no motion was made for a preliminary injunction. The patent of May 26, 1891, not having been referred to or introduced in evidence, all claims under it were abandoned, and the case of complainants rested solely on patent No. 204,741, of June 11, 1878, which contained the process claim carried out, as claimed by the complainants, by the machine illustrated in said patent and covered by claims 1, 2 and 4 thereof.

The interlocutory decree in the Supreme Court of the District of Columbia was entered February 11, 1896 (R. p. 146), eight months after the patent of June 11, 1878, had expired, and one year after the machine complained of as an infringement had been destroyed by fire (R. p. 179), the machine having actually been used but fifteen weeks. (Auditor's report, p. 154—Schedule A, R, p. 156).

The auditor's report was filed March 26, 1897 (R. p. 147), awarding \$3,491.70 as profits for the use of the machine and process during the period of fifteen weeks. (Schedule A, R. p. 156.)

Exceptions to the auditor's report were filed April 8, 1897 (R. p. 157), and on December, 1898, motion was filed to vacate

the interlocutory decree so far as the fifth claim of the patent in suit was concerned, as the auditor had returned no profits or damages due to The Hickok Manufacturing Company by reason of the purchase of the alleged infringing machine.

These exceptions and the motion to vacate were overruled on January 19, 1899, and the auditor's report ratified and confirmed, and amended final decree entered April 4, 1899. (R. pp. 158, 159.) From this final decree appeal was taken to the Court of Appeals for the District of Columbia, allowed, and exceptions filed April 19, 1899. (R. p. 160.)

The Court of Appeals of the District of Columbia, in an opinion by His Honor Judge Alvey (R. p. 223), affirmed the decision of the Supreme Court of the District of Columbia, February 6, 1900. (R. p. 236.)

From this decision appeal was taken to this court, allowed May 1 and perfected June 13, 1900. (R. pp. 236-237.)

SPECIFICATION OF ERRORS RELIED UPON.

The decree of the lower court is alleged to be erroneous for substantially the same reasons given in the case appealed to the Court of Appeals of the District of Columbia, printed at page 160 of the record, and recited in the opinion of His Honor Judge Alvey (pp. 225 and 226 of the printed record), which are more briefly stated as follows:

1. The trial court, sitting as a court of equity, had no jurisdiction of the case.

(a) Because the bill of complaint, taken in connection with the contract or agreement published at page 96 of the record, of which profert was made, and with the answer of defendant, showed that complainant had a complete and adequate remedy at law.

(b) Because at the time of the hearing it appeared from the record that the only patent before the court had expired before the hearing, no motion for preliminary injunction having been made prior to the expiration of the patent, and defendant being a mere user of one machine, which machine was destroyed by fire before the case was brought to hearing.

2. That the patent in suit, so far as the fifth or process claim is concerned, is void, not only on its face, but in view of the evidence, because it is, as the evidence shows, but a mere function of the machine.

3. That the patent is void for want of novelty by reason of anticipation by public and common use prior to any alleged invention of Jones, and also by reason of anticipation by the prior state of the art, as shown by the evidences of the witnesses and the patents and publications in evidence, and particularly by the process practiced on the Palmer press years before the application for the patent in suit was filed.

4. That the patent is void for want of invention, so far as the fifth claim is concerned, because the process had been in use and practiced without the use of any machine to assist in carrying out the alleged process long prior to any invention of Jones.

5. That claim 4 of the patent is void for ambiguity.

6. That the patented machine used by defendant, in view of the state of the art preceding Jones' invention, did not infringe any claims of the patent in suit.

7. That the trial court erred in not granting the motion of defendant to vacate the interlocutory decree after the auditor had made his report, and in view of the evidence disclosed in the record and the evidence brought out before the auditor on accounting.

8. That the trial court erred in overruling the exceptions to the auditor's report and account, and adopting the principles upon which the account was stated, and particularly because the account was based wholly and entirely upon supposed profits or savings which occurred in the printing office, and before the printed sheets were folded into signatures, whereas the patent only relates, so far as the fifth claim is concerned, to signatures after they have been printed, dried, folded and smashed.

9. Because the report of the auditor, the decree of the Supreme Court of the District of Columbia, and its affirmance by the Court of Appeals of the District of Columbia, are all based upon incompetent evidence and expert testimony relating to a supposed process not disclosed, referred to or even suggested in the patent in suit.

10. Because the court erred in approving the report of the auditor and his method of comparison in ascertaining the profits returned, the comparison being between the improved hydraulic press of Jones, which was the subject of numerous patents to Jones subsequent to the patent in suit, and a process of removing type indentations from flat printed sheets, before folding, by what is known as the old ponderous process, not in use in

any establishment for many years prior to the Jones invention, and not for a half century prior to the time of infringement, instead of between the structure shown in the Jones patent, the modern smasher and the process practiced on the Palmer press, set forth and fully described in prior publications, and particularly in the Dingman patent of October 20, 1863.

JURISDICTION.

The court, sitting as a court of equity, had no jurisdiction to order an injunction at the time the bill of complaint was filed, because the bill showed on its face that the complainants, Jones and The W. O. Hickok Manufacturing Company, had entered into an agreement, profert of which was made, whereby Jones gave the exclusive right under the patent in suit, and under all of his patents allowed and applications pending for improvements upon the same invention, to The W. O. Hickok Manufacturing Company, for a specified royalty upon each machine manufactured and sold by Jones' exclusive licensee, reserving no rights to Jones, the patentee, for either machine or process outside of the specified royalty, based upon the selling price of the machine, which included the alleged process covered by the fifth claim of the patent in suit. The grant (for it was a grant) in the agreement, profert of which was made, and which is printed at page 96 of the record, included not only the patent in suit, but numerous other patents specified in the agreement, which, being subsequent, could not, of course, include the process claim. There was, therefore, a complete and adequate remedy at law, whether the alleged infringing machine, or any number of them, contained any of the inventions in any of the patents granted subsequent to the patent in suit.

Jones was a mere nominal party to this suit, and entitled to simply 25 per cent. at the time the contract was executed, or less if modified according to the terms of the contract. The Hickok Manufacturing Company were entitled simply to the profits it would have made had the defendant purchased the machine from it, instead of from a third party. This is the real conclusion drawn from the bill of complaint as filed, raised by the answer of the defendant, and confirmed by the testimony of Jones in his answer on page 218 of the record.

"XQ. 2. Had The Hickok Manufacturing Company sold the machine to Mr. Busch, instead of The Seybold

Machine Company, you would have had no claim against him for damages or profits, would you?

"A. No."

The question, then, was simply a question of accounting at the time the bill of complaint was filed, so far as the patent of June 11, 1878, was concerned; and it is believed, also, so far as the later patent of May 26, 1891, was concerned, because that and others were included in the exclusive license or grant. But the later patent, having been dismissed from the suit by implication, the complainant not having introduced it in evidence, or taken any testimony in relation to it at the close of their testimony, the bill was evidently framed to avoid the question of jurisdiction. This is confirmed by the facts, inferred from the bill of complaint, and by the further fact that the patent had never been sustained by any court and no motion for preliminary injunction ever made. The patent had but a short time to run, and had actually expired before the testimony was closed, long before the case could be reached for hearing, and after the single machine which was sued for infringement had been destroyed by fire.

The question of jurisdiction, if not settled by the pleadings and the proofs taken thereunder, therefore, becomes a question of fact to be determined on the hearing. At the first hearing, upon which the interlocutory decree was entered, it clearly appeared that the court had no jurisdiction, for the reasons above stated; first, the only patent before the court had expired, no motion for preliminary injunction had been made before its expiration, and the single machine used by defendant had been destroyed by fire, and at the time the decree was entered the defendant had purchased and was using at the state bindery in Harrisburg, Pa., one of the complainant's improved signature presses. It was clearly the duty of the court to dismiss the bill before the interlocutory decree was entered.

Way vs. Way, 64 Ill., 406.

"Although the question is not raised by the pleadings or suggested by counsel, and where not apparent upon the face of the bill, or the bill is framed to avoid the point, if, looking at the proofs, it appears that the

(7)

case is one for which there is a plain and adequate remedy at law, it is the duty of the Court to decline jurisdiction and dismiss the bill."

Dumont et al. vs. Fry et al., 12 Fed. Rep., 21, and cases cited, especially Lewis vs. Cook, 23 Wall., 466.

Campbell vs. Ward, 12 Fed. Rep., 150.

McConnell vs. Prov. S. L. A. Soc., 69 Fed. Rep., 113.

Root vs. L. S. & M. S. Ry. Co., 105 U. S., 189.

Burdell vs. Comstock, 15 Fed. Rep., 395.

Davis vs. Smith, 19 Fed. Rep., 823.

Mershom vs. J. F. Pease Furnace Co., 24 Fed. Rep., 741.

Racine Cedar Co. vs. Joliet Wire Check Blower Co., 27 Fed. Rep., 368.

The only question, therefore, to be determined is how much profit would the complainant have made had the defendant purchased from The Hickok Manufacturing Company the steam power press manufactured by it, or the Jones hand-power press from The Hickok Manufacturing Company, instead of purchasing the alleged infringing machine from The Seybold Machine Company. The hand-power machine, which is printed in front of page 91 of the record, The Hickok Manufacturing Company sold for \$350.00, which machine, it is apparent, is a great improvement over the wooden machine represented in the patent sued on, and the Jones steam-power press printed on the preceding page, which The Hickok Manufacturing Company sold for \$500.00, was a great improvement over the Jones hand-power press, which hand-power press, although a great improvement over the wooden press shown in the patent in suit, would not do the work defendant was required to do by his contract.

Jones' testimony, questions and answers 86, 87 and 88, R. pp. 218 and 219.

Miles' testimony, questions and answers 7 to 10, R. p. 221.

Busch, cross-question and answer 27, page 181; re-direct questions and answers 44 and 45, page 184.

This is a much simpler case than that before His Honor Judge Blodgett in Campbell vs. Plano Mfg. Co. et al., 24 Fed. Rep., 738.

In that case His Honor said the only question to be established was the number of machines to be accounted for, "and this can be established as readily and completely in a suit at law as in a suit in equity."

Section 724, Revised Statutes, quotes the code of law with full power to compel the production of books and papers as evidence under all circumstances where they might be compelled to produce the same in chancery cases, and this power, the unquestioned right of plaintiff to examine all the agents and employees as witnesses, seems to give all the facilities required for a complete remedy at law.

Judge Blodgett gives the same interpretation to the decision of the Supreme Court in *Roots vs. Railway Co.*, 105 U. S., 189, as has been given to it by nearly every court since the rendition of that decision, and states that the decision proceeds upon the ground that all patentees have an adequate remedy at law in suits against infringers, except in cases where there is a right to injunction as part of the relief sought, but in all cases where the only question is as to the amount of profits and damages, and if the complainant is not entitled to an injunction, the remedy is at law.

Whatever facts may have existed prior to that decision as to the right of the parties to sue in equity, they are fully discussed in the opinion and finally settled, and nearly all decisions (at least in patent cases) since that decision have followed it, and notably the decision above referred to in the 12 Fed. Rep.

An instructive case on this point is *Spring vs. Domestic Sewing Machine Company*, 13 Fed. Rep., 446.

In that case an interlocutory decree had been entered and an order of reference to a master made for accounting, no objection having been taken to the bill or to the jurisdiction of the court. In view of the decision in *Roots vs. Ry. Co.*, then just published, defendant's counsel moved for a rehearing on the ground of want of jurisdiction, just as defendant's counsel did in this case. The decree theretofore entered was opened and the bill dismissed.

To the same effect is *Curry vs. McCauley et al.*, 11 Fed. Rep., 365. In that case the court dismissed the bill *sue sponte*. Complainant had a legal remedy when the suit was filed.

Cecil Nat'l Bank vs. Thurber et al., 59 Fed. Rep., 913.

(9)

In *Whitehead, Trustee, vs. Entwistle*, 27 Fed. Rep., 778, a demurrer was sustained because complainant had an adequate remedy at law. Defendant was, therefore, under Section 723 R. S., and Article 7 of the Amendment to the Constitution of the United States, entitled to right of trial by jury.

Consolidated Middlings Purifier Co. vs. Wolf et al.,
28 Fed. Rep., 814.

The question in the present case upon the bill of complaint, and the facts shown in the record, is: Can the complainants maintain their bill on the equity side of the court after the patent had expired, after the machine complained of as an infringement had been destroyed by fire, and no proof whatever that there was any continuing infringement intended or possible. It is elementary that a party who has a plain, adequate and complete remedy at law can not successfully invoke the jurisdiction of a court of equity.

Ross vs. City of Ft. Wayne, 58 Fed. Rep., 404.

It is plain from the record that the suit was not brought for injunction, but to evade the question for the purpose of bringing a suit in equity instead of at law.

In the opinion of the Court of Appeals affirming the decision of the Supreme Court of the District of Columbia, on pages 226, 227 and 228, several decisions are cited in support of the decision arrived at by the Court of Appeals of the District of Columbia. It is believed that not one of these decisions has any bearing upon this case.

The first decision relied upon is *Clark vs. Wooster*, 119 U. S., 322-325. The quotation from the opinion by His Honor Mr. Justice Bradley shows clearly that the facts in that case are wholly different from the facts in this case, and, while the case of *Roots vs. Railway Co.*, 105 U. S., 189, is cited with approval, His Honor also recites the facts of that case which take it out of the ruling of *Roots vs. The Railway Co.*, which facts are entirely different from the facts in this case. In that case the folding guides which were illegally procured while the patent was in force were still being used, and the prayer for injunction against the continuing infringement, still existing at the time the case was tried, was proper. These were the only facts that

took that case out of the ruling in *Roots vs. Railway Co.* In this case the facts were entirely different. Before the expiration of the patent, and before the hearing of the case, the single machine charged as an infringement was destroyed by fire. The right to an injunction ended before the patent expired, before the case came into the Supreme Court of the District of Columbia, and there was no right to an injunction, as none had been applied for during the life of the patent.

The next case cited is *Beedle vs. Bennett*, 122 U. S., 71. The quotation from the opinion in that case ought to be sufficient to defeat complainant's right, for the facts in this case are precisely what the court in that case states gives the party the right to a trial by jury in a case at law, as well settled by the decision of the Supreme Court in *Roots vs. Railway Co.*, as the following quotation will show :

"But it is clear that if the bill upon its face, or the evidence produced, gives rise to a fair presumption that the suit was instituted in equity merely to evade an action at law, the bill will not be entertained (*Roots vs. Railway Co.*, 105 U. S., 189-211), for it is now a well-settled principle that a bill in equity for a naked account of profits and damages against an infringer of a patent can not be maintained; that such relief ordinarily is incidental to some other equity; the right to enforce which gives to the patentee his standing in court, and that the most general ground for equity interposition is that which tends to insure to the patentee the enjoyment of his specific right by injunction against a continuance of the infringement. 105 U. S., 215, 216."

The next case cited by His Honor Judge Alvey (page 228) is the case of *Mills Mfg. Co. vs. Whitehurst*, 56 Fed. Rep., 589-594. That was not a well-considered case, but the facts in the case were that the patent was still in existence at the time the opinion was rendered, and the alleged infringer was continuing to use machines which the court found to be an infringement upon the patent, and there was no proof in the case that there was any established license fee granted by the patentee, either exclusively or otherwise, to the complainant. It is hardly necessary, however, to give much consideration to this case, because a petition for rehearing was granted, on application of

defendant, by the same judge who tried the case, which is reported in 60 Fed. Rep., 81. Upon proofs furnished on rehearing before the same judge, the petition for rehearing was sustained and the bill of complaint dismissed. (65 Fed. Rep., 996.) An appeal from this decision was taken by the complainant to the Circuit Court of Appeals for the Sixth Circuit, and was tried before Judges Taft, Lurton and Hammond, and in an opinion rendered by His Honor Judge Taft, the decree of the Circuit Court dismissing the bill of complaint was affirmed with costs. 72 Fed. Rep., 496.

The Court of Appeals also stated (page 228 of the record) that the principle upon which the decision of the Supreme Court of the District of Columbia was affirmed is laid down as clear law by the Supreme Court of the United States in the case of *Birdsell vs. Shaliol*, 112 U. S., 485-487. That case lays down no such law, although there are some facts in it which place the parties complainant in nearly the same position that the complainants are in this case.

In that case the patentee, like Jones in this case, had given an exclusive license for a specified territory to manufacture, use and sell machines covered by the patent. An infringer began to manufacture machines containing the patented inventions. The patentee sued the infringer without joining his exclusive licensee. On accounting he was adjudged to be entitled to recover the amount of his license fees (so much per machine), but without costs and without any right to injunction against the infringer. He subsequently, as trustee for his licensee, brought a suit, practically for the benefit of his licensee, to enjoin the sale of the machines made in infringement of his licensee's right. As the court had in the prior suit determined that the patentee himself had no right in equity, the claim was made that the patentee had no right to bring a suit for the benefit of his licensee for an injunction and accounting for the profits the licensee would have made had the infringer purchased the machines from the licensee, instead of having manufactured them himself. The Supreme Court held in that case that the suit brought by the patentee for the benefit of his licensee to enjoin a continuing infringement during the life of the patent, and for profits made by the infringer by the manufacture and sale of the machines, less the royalty that had been recovered by the patentee, gave the licensee a standing in a court of equity.

But in that case, as in all other cases in which the decision

in *Roots vs. The Railway Co.* has been followed, it has been made to appear that the infringement was a continuing one, and the proper remedy against the continuance of the wrong was an injunction. No such facts appear in this case.

In *McDonald et al. vs. Miller*, 84 Fed. Rep., 344, the same interpretation is given to *Roots vs. Railway Co.*, *Clark vs. Wooster*, and *Beedle vs. Bennett*, as above contended for by appellant, His Honor Judge Seaman stating, in that case, that the formal right to an injunction, without the actual need or intention to exercise it, is not sufficient to give a court of equity jurisdiction.

In referring to *Clark vs. Wooster*, 119 U. S., 322, His Honor says :

"The trial court having proceeded to a decree without objection by the defendant, it was held that jurisdiction appearing 'at the inception of the suit, even though upon a narrow ground' — namely, the present right to an injunction — retention of the bill, under the circumstances, was so far discretionary that the decree will not be reversed; but the opinion clearly recognizes the general doctrine as above indicated."

This case also cites *Hayward vs. Andrews*, 106 U. S., 672, which also gives the proper interpretation to *Roots vs. Railway*, and His Honor Justice Matthews, in rendering the opinion of the court, cites

Thompson vs. Railroad Co., 6 Wall., 134;

Walker vs. Dreville, 12 Wall., 442;

Morton vs. Morton, 99 U. S., 330;

Hunt vs. Hollingsworth, 100 U. S., 103,

quoting from the opinion of Mr. Justice Davis in the case in 6 Wall. :

"The absence of a plain and adequate remedy at law is the only test of equity jurisdiction, and it is manifest that a resort to a Court of Chancery was not necessary to enable the railroad company to collect their debts."

In this case, like that, the complainants had a plain and adequate remedy at law, and the Supreme Court of the District of Columbia should have dismissed the bill.

PATENT IN SUIT.

The only patent that we need to consider is the patent of June 11, 1878, No. 204,741, and this will be considered regardless of the state of the art preceding the alleged invention of Jones, excepting only such public and common use as the court may take judicial notice of, and which was known to all persons skilled in the art prior to any alleged invention of Jones.

The title of the patent is "Bookbinders' Dry Press and Sheet Tie." In the specification the invention is stated to be an improvement in bookbinders' dry press and sheet tie, and it is stated that the invention is fully disclosed in the specification and accompanying drawings. The standard dictionaries describe a dry press as a press used in printing, in which sheets are pressed smooth. This is the definition given in the Standard Dictionary of the English Language, in Knight's Mechanical Dictionary and other well-known publications.

A smashing machine is defined in the dictionaries as "a heavy and quick press used by bookbinders to flatten and smooth and make solid the springy folds of books before they are sewed," which is practically the same definition given for a dry press in the Standard Dictionary, to wit:

"Dry Press — In printing, a press for smoothing printed sheets."

The same dictionaries give:

"Press Boards — *In printing*, smooth and neatly jointed boards of wood, between which printed sheets are pressed in a standing press."

"Pressing Boards (2) — One of the smooth, jointed boards, of pine or cherry, used in standing presses."

The definition of signature in the dictionary is:

"Signature -- especially in bookbinding — a sheet after it has been folded and is ready to be gathered."

These are the technical terms used in the patent, and were well known many years before any alleged invention of the patentee Jones.

It was equally well known prior to the Jones invention that sheets of printed matter, after leaving the printing press, were dried and folded before they went to the bindery, where they were gathered into signatures, smashed and tied up in bundles, ready to be used when they were to be sewed and bound into

books. There is no dispute, and can be none, so far as the above facts are concerned.

Looking now at the patent: What did Jones invent, as shown by the drawings, described in the specification and particularly referred to in the claims? Looking at the drawing, Fig. 1, it discloses a smashing machine on the right hand side. Connected to it on the left hand side is a press with a bundle of folded signatures in it ready for removal from the press. Fig. 2, as shown and described, is a perspective view of a bundle of sheets tied and ready for setting aside, and Figs. 3 and 4 are detail views of divided presser heads for the press, to permit the operator to pass his hand between the divided heads and tie the bundle before the pressure is removed.

The third paragraph states the object of the invention, which is, first, to furnish a bulk compressor device, to be used to prepare the matter properly before it is inserted in the dry press proper, thus saving time and repeated travel from the smasher to the dry press before the operation of tying. (Presumably as was done prior to the Jones improvement.) The second object of his invention is stated to be to furnish a dry press proper, in which the pressing parts or heads are divided or have ways through them to readily manipulate the twine to tie the bundles while they are still under pressure, in order to retain the force of the press after the bundles are removed.

The third object of his invention is to provide slots in the sides of the press, which correspond with the press heads, to pass the twine through and around the sides of the bundle while the pressure is on.

The fourth object is to provide an alternate arrangement to adjust the press trough to different sized bundles, and the fifth object of his invention is a new process for treating *printed and folded sheets of paper* in dry pressing, consisting of subjecting a collection of such sheets to pressure without the use of fuller boards, and, while under such pressure, tying them into compact bundles, with end boards thereon; then removing them immediately from the press and allowing them to remain tied sufficiently long to fix and complete the dry pressing. This is practically the language of the fifth or process claim.

The fifth or process claim of the Jones patent, No. 204,741, in view of the specification and drawings, is misleading, and must be spelled out in order to determine exactly what it is,

but eliminating the senseless statements and surplusage, it will read as follows:

The process herein described for treating folded printed sheets of paper, the same consisting of subjecting a collection of such folded and printed sheets to pressure and, while under pressure, tying them into compact bundles between end boards, in order that the said tied bundles may be removed immediately from the press and the pressure retained until the pressed signatures are desired for use.

It is believed the above is a fair reading of the claim.

In view of this statement, and public and common knowledge, regardless of what the anticipatory matter may disclose, or the testimony of experts, what is this patent?

In every baling press it is well known that the material, whatever it is, must be subjected to pressure. It is well known that bands, strings or ties are put around the bales to retain the pressure. It is well known that these bands can not be put around the bales while under pressure, unless there is some provision, in the pressure head and in the sides of the trough, box or other receptacle, to allow the bands to be passed around and tightened while the pressure is on, secured while the pressure is on, and removed from the press to retain the pressure.

The above facts were matters of common knowledge. It was also a matter of common knowledge that merchants or manufacture, in whatever branch of business engaged, folded packages or bundles, whether sheets of paper, dry goods, groceries, pictures or any other line of goods they dealt in, in compact bundles, putting such pressure on as could be done by hand, tying them in two or four ways, if desired, and allowing them to remain tied, to hold whatever pressure is put upon them, until the merchandise, goods or whatever it was, was desired to be used.

What did Jones invent, as disclosed by his patent? He did not invent a bulk compressor, dry press, standing press, or smasher. Whatever it may be called, it is the same machine. Although it is shown in his drawings and in his specification, he makes no claim for it, nor does he make claim for it as an element in any combination, excepting the process of the fifth claim. He did not invent that.

From his specification, he did not invent any new process for removing type indentations; none of his claims is to that, or refers to it, and it was well known long prior to the Jones

invention, and it is obvious that if any type indentations are to be removed, they must be removed after the printed sheets have been dried, before the printed sheets are folded, especially under the modern practice, in use at the date of the infringement, by machine folding, which subjected the sheets to the action of rollers into which the sheets were driven and passed, and especially before they went to the smasher, which smoothed the sheets, drove the air out from between them, and the old smashers, used more than a half century ago, as shown in well-known publications, exerted a pressure of from fifty to eighty tons. All of this work was done long prior to the Jones invention, as disclosed in his patent, to wit: they were printed, dried, folded and smashed.

From the patent it would appear that the smasher was not connected with the bundling press, and the first object of the Jones invention was to connect the smasher with the bundling press, standing press, dry press, or whatever it may be called, that was used in book bindery work, so as to avoid the trouble and loss of time in traveling from the smasher to the bundling or tie press.

It then appears, upon the face of the patent, and in view of what was old and well known, that there was no novelty whatever disclosed in the Jones patent, excepting only the attachment of the dry press to the smasher, so far as the fifth claim is concerned, and nothing in the dry press or bundling press or sheet tie, whatever it may be called, shown at the left hand of Fig. 1, that had not been used in every old bundling or baling press ever used, to wit: compressing the material to be acted upon, tying the material in bundles while under pressure, removing the material from the press, allowing the ties to hold the pressure until it was desired to use the material, whether hay, cotton, wool, manure, tobacco or any other material that required baling to put it upon the market.

The structure disclosed in this patent involves no invention, in view of the well-known facts above stated. The case in favor of the patent is not so strong as that decided by the Supreme Court in *King vs. Gallun*, 109 U. S., 99, affirming the decision of His Honor Judge Drummond in *King vs. Trostel et al.*, 16 O. G., 956. There was but one claim of the patent relied on in that case, and that was for the bale as a new article of manufacture. That the bale was new, so far as baling plastering hair was concerned, was not disputed, but the Supreme Court, speak-

ing by Mr. Justice Woods, held that it involved no invention, in view of the fact that it was well known that the packing of articles of commerce into small parcels for convenience in handling and retail sale, and tying them together into bundles for convenience in *storage* and transportation, is as common as any fact connected with the trade. The opinion cites, as matters of common knowledge, packages of wool, feathers and plug tobacco as having been treated in the same manner.

That the described process is merely a function of the machine, and therefore not a proper process claim under the ruling of this court in *Risdon Locomotive Works vs. Medart*, 158 U. S., 68; *Westinghouse vs. Boyden Power Brake Company*, 170 U. S., 537; the universal decisions of the Supreme Court, the United States Circuit Courts and the United States Circuit Courts of Appeals, since the rendition of that decision, seems almost too clear to require discussion, and is practically admitted in the decision of His Honor Judge Alvey, on page 228 of the record, unless there is some elemental action involved, and he finds that elemental action to be "tight cohesion under a high degree of pressure, effected by a special mechanical contrivance, and to produce new and beneficial results by such means or process."

Whatever the elemental means may be, or the chemical action (which, it is admitted, is not involved in the fifth claim), it must be a new discovery. Jones discovered nothing. It was well known that "tight cohesion under a high degree of pressure effected by a mechanical contrivance" would flatten out and smooth anything subjected to it. The patent admits that prior to the Jones invention this was done by what was termed the old ponderous process, and the pressure was retained *ad libitum* by allowing the article under pressure to remain in the press for the desired length of time. It was well known long prior to Jones' invention that this "tight cohesion" was produced in all baling processes, the tight cohesion of the press held by bands or ties while the material was under pressure, and the bale or bundle immediately removed from the press.

This case can not be brought within the decision of the United States Court in *Cochrane vs. Deener*, 94 U. S., 780; *Tilghman vs. Proctor*, 102 U. S., 707, or the telephone cases, 126 U. S., 1.

The elemental action in *Cochrane vs. Deener* was utilizing the force of gravity to carry heavy substances down from an

elevation, while passing a current of air through the whole mass to drive the lighter substances upwardly and separate the two, and it was new with the patentee.

In *Tilghman vs. Proctor*, the new discovery was that, in subjecting fat mixed with water in a closed vessel to a temperature of four hundred to six hundred degrees, the chemical combination would be broken up and the glycerine, fatty acids and the water, when the temperature was reduced, would be held in mechanical combination and easily separated. The material underwent a change by both of these processes, and it mattered not by what mechanism the separation was effected.

In the telephone cases, the inventor employed a vibratory or undulatory current of electricity, which had never been applied before, in contradistinction to the merely intermittent or pulsatory current, and the apparatus for producing electrical undulations upon the wire, which apparatus had never been employed before.

Under these decisions, any old machines might be employed to carry out the process, and still be an infringement upon the patents, because the result had never been produced. For instance, the machine or apparatus shown in the *Cochrane* patent was never used, but the old separating machines were employed, with improvements that accomplished a result that never was accomplished before. In *Tilghman vs. Proctor*, no infringer ever dreamed of using the machine or clumsy apparatus described in the *Tilghman* patent, but used a common kettle, with sufficient strength to resist the pressure put upon it. These old kettles and the reels, middlings purifiers and separators, when changed to produce the separation described in the patents in suit, were not infringements, because no old machine had ever produced the result. Jones' alleged process, if tight cohesion was the element he employs, was used in every baling press ever invented or used. It was used in the press involved in the suit above referred to — *King vs. Gallun*, 109 U. S., 99. It was also used in the *Dedrick* press of October 29, 1872, and June 2, 1874, both of which patents were long prior to the Jones invention, and the reissues of which were involved in *Dedrick vs. Cassell et al.*, 9 Fed. Rep., 306.

This court can certainly take notice of its own decisions and the published opinions of the United States Circuit Court of Appeals, when the court's attention is directed to them, as matters of public and common knowledge. The court, refer-

ring to the Dedrick patents, on page 313, in describing the patent in that case, states :

"The language of the specification is 'the follower *O*, with tying grooves, is inserted in the press box in rear of the finished bale and forced along with it,' thus constituting a partition between the bales and facilitating the passage of the bands. In the original patent a single claim was founded on this, in the following words: '(10) The follower *O*, constructed with grooves on both sides, in combination with the bale-chamber,' etc."

We there have the press, the follower, or press heads, with tying grooves in them, and the press box, which is, of course, grooved to allow the bales to be tied while under pressure. In the reissue two claims were founded upon this single claim :

"(6) The follower *O*, constructed with grooves on both sides for the ties, in combination with the bale-chamber," etc.

On page 315, in speaking of the claim of the reissue 8,296, the court say :

"On the reissue 8,296, the only claim involved is the following: 'the press or case provided with one or more apertures (*O*) for the purpose set forth.' "

No objection was found to this claim, because it was a useful improvement or addition, and with Dedrick it was new. As the court say in the next paragraph :

"It was very plainly described in the specification, and, although an occasional use of it only was then contemplated, the propriety of inserting it in the reissue can not be now questioned."

We have, therefore, in this press the follower, or head, provided with tying slots, and the case provided with one or more apertures to permit the tying bands to be passed around and hold the pressure of the press when the bale is removed. The

court in that case held the claim valid, because it was new with Dedrick. If it was new with Dedrick in 1872 or 1874, it can not be new with Jones in 1877, nor could he be entitled to a patent upon a process claim which was refused to Dedrick on a patent issued long before Jones' invention. The baling press was also described in *Fox vs. Camp*, 10 Fed. Rep., 675. The patent in that case was granted August 27, 1867, to Charles Brown, and was first before the Circuit Court for the Southern District of New York before His Honor Judge Wheeler, reported in 3 Fed. Rep., 898. In that case the validity of the patent was denied because the defendant, the licensee, had acquired a prior patent for the same process, in which the well-known process of baling hay was applied to other kinds of hay than short-cut hay. His Honor Judge Wheeler, on page 899, says:

"There is considerable doubt whether the patent, as between the owners and the public generally, is of any validity. Hay has long been baled, to the common knowledge of all. The whole invention in controversy consists in baling hay, cut short, in the same manner, etc."

It is evident that the appeal in this case would have been dismissed had defendants not been estopped from alleging the invalidity of the patent. But the case was sent to a master to take account of damages and profits, and the master in that case adopted the same rule as the auditor did in this case. It came before His Honor Judge Blatchford on exceptions to the master's report in the case above cited (10 Fed. Rep., 675), and the report was set aside.

The specification of errors herein assigned is believed to be in compliance with the rules of this court, but in referring to the evidence the same testimony may apply to several assignments. If the separate assignments were taken up in numerical order, it would cause unnecessary repetition. The testimony referred to next will necessarily apply generally to assignments 2, 3, 4 and 9, as that appears from the printed record, pages 222 to 235, to be the order in which the evidence was considered by the Circuit Court of Appeals for the District of Columbia.

REFERENCE TO EVIDENCE.

It is clear, from the opinion of the Court of Appeals of the District of Columbia, paragraph beginning near top of page 231, that said court erred in basing its decision upon incompetent testimony, particularly as specified in assignment No. 9.

The state of the art, as set out by Mr. Jones himself, the patentee, is quoted by the court from Jones' answer to XQ. 38, page 31. The concluding statement of this answer clearly shows that the old process referred to by Jones was, as he states, "This was all done before the folding of the sheets." And it was done upon flat sheets in the printing room and before the sheets reached the binder, while the Jones process, as described in his patent, has nothing to do with the sheets until after they are folded into signatures after they have been printed, dried, folded and smashed, and the press was not intended to be used on the flat sheets — cross-question and answer 56, page 34:

"XQ. 56. Is the press shown in your letters patent No. 204,741 capable of bundling and tying papers other than folded, printed signatures?

"A. It was not so intended. The limits of its capabilities I am not prepared to say."

In Jones' answer to XQ. 40, page 32, he gives the same definition of dry press and dry pressing as is given by Nicholson in his work published in 1856, an abstract of which is given in the testimony of the witness Hood, record pages 102 and 103.

Jones admits in his testimony (page 209) that there is nothing in the patent referring to any advantages by omitting the drying process prior to the time the sheets were folded, although he admits that he discovered that the old, ponderous process, as it is termed, was not necessary in a modern printing press.

"XQ. 51. Is there anything said in the specification of the patent No. 204,741, setting forth the advantage obtained by pressing the sheets of signatures without first subjecting them to the drying process, or any suggestion that the sheets could be so treated?

"A. I do not know that it does. There is a copy of it here, which is printed, and can be ascertained by reading the specification. If I had an expert patent attorney, as either yourself or Mr. Jacobs, if it is not

inserted, I presume it would have been, for I knew it to be a fact when I gave him the case, but, unfortunately, he was one of those gentlemen who work very slow — supposed he knew it all — and I, having very little, if any, experience in the taking out of patents, he had his own way of making the specification and claims."

"XQ. 52. Did you not discover the omission when he read the specification over before you signed and swore thereto?"

"A. I can't say whether I did or not."

"XQ. 53. When did you discover it, if not then?"

"A. I can't even fix that time; it may have been some time after I obtained the official letters patent."

See also XQ. 57.

This expert witness' attention is also called to the Dingman patent of October 20, 1863, printed at page 123 of the record, and also to the Palmer press, printed after the deposition of Harrison P. Hood, record page 118.

He practically declines to answer a plain question in relation to this Dingman patent; terms it a cotton press, and does not think it could be used in the shape of the drawing for the purpose of dry pressing printed sheets, or that the work could be accomplished on it; but he gives no reason, and in the next question (XQ. 63, page 211) he is asked:

"XQ. 63. If a bundle of printed signatures were substituted for the ream of paper, and end boards were used, would the pressure be retained after the bundle was tied and removed?"

"A. I do not think I should be called upon to bring out, or endeavor to do so, the new inventions on old patents such as these, neither am I here to testify to the inventions of others."

He is also asked if the Jones process could be practiced on the John Palmer press. His answer is, "Not as this cut shows."

"XQ. 68. Why?"

"A. Because the head and back folds of the sheet

could not be placed and held in alignment. They would mash out when the pressure is applied."

In short, the difference he finds between the Palmer press and the process practiced on it, as testified to by the witnesses Schrank, McKee and Davis, printed at pages 164 to 173 of the record, and the Jones press or process, is that it is intended in the Palmer press to turn the signatures head and tail, as he terms it, that sufficient pressure could not be exerted upon it, and that two strings are used in the Palmer press, while only one was necessary in the Jones press and process; but the patent, as he admits (XQ. 74, page 215), says nothing about the amount of pressure to be applied, nor about which way the sheets should be turned before being put into the press, excepting that he claims the drawing might show that they were all placed one way; nor is there anything said in the patent about one, two or any number of strings being used, nor about the bundle being tied in one direction, as shown in the Dingman patent, or in two directions, as practiced on the Palmer press.

Jones is asked (XQ. 77, page 216) if the sheets were subjected to the action of a smasher before they were placed in the press, if the Palmer press would then make a compact bundle out of such smashed sheets, and he answers in the affirmative.

"Under those conditions, the sheets being smashed perfectly flat and soiled, and the air displaced between the sheets, I think it would be capable to place such sheets in the Palmer press and tie them into bundles."

* * *

Before this answer was closed adjournment was had, and after adjournment witness desired to add to his answer. In this he describes practically the process that was gone through with in his patent.

"The Palmer press is incapable of performing the work of making a compact bundle prior to the smashing."

The Jones patent shows that his bundle is smashed before being subjected to the press and sheet-tie proper. He says, further, "even then it would not be capable, because it has no

side guides to even up the sheets. They would slip and quash out, smear and blur the printing. The guides in my press prevent this, and there are no guides in the Palmer press."

It is submitted that it would not be invention to add side guides to the Palmer press. It is also evident that, if it were material to consider the drawing, description and size of the parts as given by the witness, the Palmer press would be equally as powerful, if not more so, than the wooden hand press shown in the drawings of the Jones patent, but the process would be the same, and the machine would be the same, regardless of its size, as it is a problem for a mechanic and requires no invention to construct a machine adapted to the character of work it is intended to perform.

It will be noticed that the testimony of Jones quoted in the opinion, page 231, was given on the prima facie case, and the state of the art was not before him at the time he gave such testimony. He did not at that time know of the Dingman press and the other presses referred to by him in his subsequent testimony, nor did he know of the Palmer press or the work that had been done on it, and when he gave that testimony he was totally ignorant of what had been done in the art prior to his alleged invention, outside of the city of Harrisburg, where he resided.

The opinion (beginning last paragraph, page 231) quotes from the testimony of the expert Robertson. The testimony quoted from Robertson was also given before he had any knowledge of the state of the art as disclosed by the patents, and the subsequent evidence taken in relation to them before he knew anything of the Palmer press, and, indeed, before he knew anything that had taken place in the art of printing subsequent to the year 1862—more than fifteen years prior to any alleged invention of Jones. See Robertson's testimony, conclusion of his answer to cross-question 16, page 43:

"About this time I became interested in sewing machines, and dropped the printing business for a time, but occasionally did a little work. The last time I worked as a journeyman printer was in 1862.

"XQ. 17. It was during the period, then, from 1850 to 1862 that you had occasion to observe the processes carried on in the art of bookbinding, was it?

"A. It was."

"XQ. 26 (page 44). Did you ever have occasion to observe any such bundles of folded printed matter from 1862 to 1874?

"A. No, sir."

"XQ. 73 (page 51). In your consideration of claims 1, 2, 4 and 5 of the Jones patent, you have considered said claims in the light of Mr. Jones being a pioneer, have you not, both in the construction of the press and the process therein set forth?

"A. I have."

This witness Robertson is called in rebuttal, and the state of the art as disclosed by the patents (particularly the Dingman patent), and public use of the Palmer press, was placed before him, and he is candid enough to state that Jones is not a pioneer, and the Jones process and press were not broadly new, and, fairly considered, was anticipated or limited by the prior state of the art. In fact, that, in view of the state of the art, what Jones did did not amount to invention, unless other things not mentioned in the patent might be interpolated as part of the Jones invention.

Before referring to this expert's testimony, a brief description of the Dingman patent of October, 1863; the Palmer press, as described by the witnesses Schrank, McKee and Davis; the Cooley patent of October 16, 1866, and the Craig patent of July 4, 1865, will tend to clearness.

First, as to the Dingman patent (page 123 of the record): The inventor, in his preamble, states that he has

"invented a new and useful machine for combining and facilitating the operation of pressing and tying paper into reams or bundles, which I call the combination paper press and tie engine."

Then follows a description of the mechanism, giving the size and dimensions of the machine, and referring to the specification by the parts. Briefly, it is a machine composed of a frame having a platen to receive the paper, divided presser heads to compress the paper upon the platen, means for bringing the divided heads down on the bundle of paper by means of a hand or pilot wheel; and it is suggested at the top of page 124 that

this pilot wheel may be substituted by a pulley, to be operated by the motive power of the mill through suitable gearing. It is also provided with a ratchet and pawl to hold the divided presser head and keep the paper under pressure while the operator passes the string around through the divided heads and ties the bundle to retain the pressure as long as desired, after which, "by a reverse movement of the hand wheel, the pawl being raised, the pressure is relieved and the paper removed."

The inventor Dingman, in describing the preceding state of the art upon which his invention was an improvement, in the first paragraph on page 125, describes what the witnesses Jones and Robertson, as quoted in the opinion of the Court, describe in more concise but substantially the same language.

It is to be noted from this that both in the old process and in the Dingman process the material to be operated upon was folded sheets. But the description goes further, and at the end of the specification describes the usual mode of tying paper in bundles at and prior to the date of Dingman's invention.

"The usual mode of tying paper is by passing a string, cord or twine around the ream, with a noose or loop, at the end through which the other end is passed, and then drawn upon with the hand until the loose ream or bundle is sufficiently compressed. This operation is laborious and tedious, requiring much time, requiring strong twine, and unavoidably draws the ream awry or the paper out of place."

Is there anything in the process of the fifth claim, aside from the mechanism described in the Jones patent, that is not fully described in the Dingman patent as having been practiced by hand prior to Dingman's invention in October, 1863?

"The following, on the other hand, are some of the advantages I claim for my press and my mode of tying."

The inventor stated that at that time he had not only invented the press, but a method or process of tying, and, continuing, states that his invention consists:

"First. It combines in one machine both the press

and the tie table, and occupies much less space than the old press alone, and can be easily moved from place to place to suit convenience.

"Second. It effects a great saving of time and labor, requiring no longer to take the paper from the finishing table, press, and tie it in this machine than it does to remove it from the ordinary press to the tie table alone. The tying process, with my press, instead of being laborious, is simple and easy, requiring comparatively light cord or twine, and leaves the ream perfectly square.

Third. The paper is pressed uniform in thickness, and no part of the ream can be moved out of place by the process of tying, since it is held firmly while this is being done.

"Fourth. Ordinarily, now a full press of paper is made before any of it is pressed. With my machine it can be pressed about as fast as it is made, so that it need not lie loose about the mill and be wasted, as is often the case in the ordinary process.

"Fifth. Instead of requiring a man, as it does for the old process, effecting comparatively little work, a boy or even a girl is sufficient to press and tie with my machine, and does more work, and does it better."

What advantages are set forth in the testimony of Jones and Robertson, taken on the prima facie case, and quoted in the opinion of the court, or set forth in the Jones patent, that is not as fully and as clearly described in this Dingman patent, issued fourteen years before Jones made his application? It has the same divided head as the Jones patent for passing the arm through to tie the folded sheets while under pressure. It is contended, however, by the witnesses, that it only ties the bundles in one way, while by Jones' process they are tied in two ways. That is not important, but if it were, we find in the Cooley patent the bundling press, having grooved platens for tying the bundle, while under pressure, in both ways. We do not find in this Cooley patent the divided heads or platens, as shown in the Jones patent, but we do find identically the same head as shown in the Seybold machine, in the Jones steam-power press, in the Jones hand press introduced by the complainants below, and in the Jones hydraulic press printed in the record

between pages 30 and 91. But the string passed in one or two or a dozen ways makes no difference, because the clamp shown in complainant's exhibit, "Jones' Form of License," printed in front of page 89 of the record, is a plain mechanical equivalent for the strings or twine, and this is shown in the Craig patent of July 4, 1865. (R., page 131.)

Robertson's testimony (R., page 87), referring to the Craig and Cooley patents:

"XQ. 49. Do you consider that the presser heads shown in the cut on the last page or back of complainants' exhibit, 'Cut of Jones' bundle or printed signatures,' to be a patentable improvement over the presser heads shown in the Jones patent in suit?

"A. I should hardly say so. It seems to me they are only mechanical equivalents of the device shown in the Jones patent in suit for the same purpose.

"XQ. 50. Do you consider the adjustable clamp shown in Figs. 3, 6 and 7, on the first page of the exhibit above referred to, to be a patentable improvement over the string or chain ties shown in the other figures on the same sheet, and also in the Jones patent?

"A. So far as I can see, it is only an ordinary clamp, but it may contain some features in the detail of construction, not now apparent to me, which would render the same patentable. I do not consider that, considered simply as a substitute for the tie, would be an improvement over the cross-tie shown in Fig. 5, because, as all the pressure on the parts comes in the center of each one, there would be a tendency for the pressure of the paper to bend the parts outward at their ends, and therefore, for the purpose of removing indentations, I should consider it an inferior device to the cross-ties shown in Fig. 5, as the pressure on the parts is equal in all directions when the cross-tie is used.

"XQ. 51. Would your opinion be the same if two clamps were used, one near each end of the bundle?

"A. I think the pressure would be more equable under the circumstances, as there would not be the same tendency to bend the board at the end.

"XQ. 52. Would the employment of either one or

two of these clamps, instead of the cross-tie, be an evasion of the fifth claim of the Jones patent?

"A. I think not.

"XQ. 53. In the employment of either one or two of these clamps, it would not be necessary to have cross-grooves in the presser heads, would it?

"A. It would not.

"XQ. 55. The grooves in the patent (Cooley) and in the illustration referred to are the same shape in cross-section and at right angles to each other, are they not?

"A. They are, to both parts of the question.

"XQ. 56. And the slots in the sides and ends of the press box are arranged in line with the groove in the Cooley patent, are they not?

"A. They are.

"XQ. 57. In the Craig patent No. 48,523, there is shown in Fig. 3 a bale held compressed by two clamp ties, passing over boards at each end of the bale to hold the pressure of the press. Is there any substantial difference between the method of holding the pressure illustrated in the Craig patent and in Figs. 6 and 7 of complainants' exhibit 'Cut of Jones' bundle of printed signatures'?

"A. No, sir.

"XQ. 63 (page 88). Would it require any invention to change the ways in the Palmer press to the shape of the ways shown in the Cooley patent?

"A. It would not. But even then such ways would not be equivalent to the cross-ways of the Jones patent.

"XQ. 64. Not even if the circular openings were made large to pass the hand and arm of the operator through them?

"A. If they were made large enough to pass the hand and arm of the operator through them, they would then be practically the same as the cross-ways shown in the Jones patent."

In Robertson's testimony (pages 84 and 85), he states, in answer to XQ. 40, that it would not require invention to provide the Palmer press with back and side guides like the Kellogg patent; but, in answer to cross-questions 43 and 44, he considers the inclined position of the trough or bed and the cross-ways as

another advantage over what is shown in the Dingman patent.

So far as the Dingman patent is concerned, the witness Robertson agrees with the witness Hood in his (Hood's) answer to XQ. 56, page 117 of the record.

Robertson considers the Dingman patent a pioneer.

"XQ. 45 (page 85). Do you consider claim 1 of the Dingman patent to refer to a process or specific mechanism?

"A. It seems to be a combination of the two; both process and mechanism. And somewhat similar claims to that in the Dingman patent, the courts have construed them to be for mechanism employed, if I recollect the decisions right.

"XQ. 46. The claim is informal, but considering it as a claim for the mechanism, as follows:

"'In a paper press and tying engine, the combination of a series of jaws, or corresponding upper and nether metallic plates, all disconnected, so that while the paper is being subjected to the required pressure it may be easily tied into reams or bundles,' would you consider the Jones press to contain such invention?

"A. If the broad construction usually given to pioneers in the art were given to this claim, I believe that the Jones press would come under that description; but it may be that, in view of the broad specific description of the parts contained in the claim, the courts would limit it to the construction shown in the drawings, which the Jones patent does not show.

"XQ. 47. Suppose it be limited to the specific elements of a claim like the following:

"'In a press and tying engine, the combination of the frame, the stationary bed plate consisting of a series of metallic plates disconnected from each other, the movable platen consisting of a series of metallic plates arranged opposite the metallic plates in the stationary bed, and means substantially such as shown to move the upper platen to or from the stationary bed for the purpose of compressing a bundle of sheets and holding the pressure while the bundle is tied,' would the Jones press contain such invention?

"A. I believe such a claim would cover the Jones machine as shown in his patent.

"XQ. 48. Assuming the first claim of the Dingman patent to be for the process, and removing the informalities, to read as follows:

" 'The process herein described for treating sheets of paper, the same consisting of subjecting a collection of such sheets to pressure and, while under such pressure, tying them into compact bundles, and then removing them immediately from the press,' would the practice of the Jones process, as it is described in the patent in suit, be within the terms of that claim?

"A. It would."

It is evident from this witness' testimony that, so far as the state of the art shows, Dingman was a pioneer, and the substituted claims which the witness was asked about are substantially the claims of the Dingman patent, only put in better shape; and if there was nothing prior, Dingman's broad generic claims would have been allowed if made.

Referring now to the Palmer press. The cut of the Palmer press is found after the testimony of the witness Hood, between pages 118 and 119 of the record, and the testimony of the practical bookbinders, Schrank, McKee and Davis, who knew of this public use of the press prior to 1874 — not only this press, but others of the same kind — begins at page 164 of the record. There is no dispute about this press having been in use prior to 1874, and it was still in the bindery and in use at the time the testimony of these witnesses was given.

Schrank, page 165:

"Q. 5. Please state what means was employed by Mr. Palmer, or in his establishment, for pressing bundles or tying up signatures while you were in his employ.

"A. They had a press there with a screw in it of about an inch and a quarter, with blocks with slots in for the purpose of taking up the slack of strings after the pressure was applied.

"Q. 6. State when that press, such as you have described, was first put in use by Mr. Palmer, if you know.

"A. He had a press made when I was out of his employ, in the year 1873, but I had used the process on another press — that is, blocks — previous to that which I had seen in use at the place of Mr. George W. Storey, who carried on the process of folding books at the northwest corner of Third and Walnut streets, when I was about fifteen years of age. I was errand boy for John Palmer. I introduced it into Mr. Palmer's shop in 1863."

(The witness was sixty-three years of age when he gave his deposition.)

"Q. 7. State how you came to introduce that press into the establishment of Mr. Palmer in 1863.

"A. I used it in tying up those signatures and bundles of books. I found I could not tie them tight with the process he had, and I proposed to him to have these blocks made that I had seen in use in Storey's place. I had them made about six by ten inches and one inch and a half thick, with a grooved slot in them, so that the slack of the twine could be taken up after the pressure had been applied, and the cause of it was that the bundles would be tight.

"Q. 8. Were those blocks used on the press the same or different from the one that was employed in 1873?

"A. They were used on a press called the Single-Screw Stewart Press, a press similar, only with heavier screws.

"Q. 9. How recently have you seen the press which you say was used by Mr. Palmer in 1873 or 1874?

"A. I think it was last Thursday, April 18, 1895, in Russell & Bates' bindery, 509 Locust street, Philadelphia.

"Q. 10. State whether it was in the same condition when you saw it last as in the year 1873 or 1874, and if there were any changes, describe them.

"A. I think the cast-iron block was broken, and they are now and have been using one of the original blocks of wood.

"Q. 11. Please examine this sketch I hand you, and state what it represents.

"A. It represents the press that was used for that purpose.

• "Q. 12. Do you notice any differences between the sketch and the press now at Russell & Bates' place, 509 Locust street?

"A. It is the same press which I have removed twice. I removed it first from the Wiler building into the Tatham building in 1874, and in 1880 we removed it into the annex of the Tatham building.

"Q. 13. What time was this press that was used at the Palmer bindery, and represented by this sketch as the Palmer press, fitted with iron blocks, as spoken about?

"A. About the year 1873, when he had it built.

"Q. 14. How are you enabled to state positively that this press was made in 1873, and moved into the Tatham building in May, 1874?

"A. I went back to Mr. Palmer's employ in February, 1874, and on the 19th of May he started to move the bindery to the Tatham building out of the Wiler building. On the afternoon of the 20th of May, in moving one of the presses, I slipped on the floor and fell, and cut my cheek, which gave me a black eye. On that night my mother died — 20th of May, 1874. I had to go to the funeral with a black eye, which I did not like to do, but I had to do it.

"Q. 15. How long after 1874 did you continue to work for Palmer?

"A. I think in 1882 or 1883 he died, and then I worked for his widow up to 1888.

"Q. 16. How extensively was this press used in the bindery while you were employed there?

"A. It was employed for two or three days in the week, and then would stand idle for a day or so.

"Q. 32. For what purpose were the books put into bundles in the Palmer establishment, as you have described?

"A. For their preservation and to save space in storage until they went to be bound and delivered to the publishers, and they stored them in their store-rooms. Among whom were the firms of T. & J. W. Johnson, law publishers, 535 Chestnut street; Messrs. Kay & Bros., on Sansom street, between Seventh and Eighth streets, on the south side; and then we stored

some for W. & O. H. Morrison, on the sixth floor of the Tatham building."

McKee's testimony (pages 170 to 172) is practically the same as Schrank's. He describes the press and process in his answer to Q. 4, as follows:

"It consists of a screw, and the platen is attached to the screw, and after the books are got between, papers are first laid on the bottom, and then a piece of paste-board, and then the books are laid on top of this, and another piece of paper on the top; and then, if they could find old sides enough of old books that were torn from books — for instance, books that were sent just for being rebound — they were saved for this purpose and put on top of the paper. After placing these on the top, this block was placed on the top of that, and the cords put through, and then they turned what I call the lever, but you call it the bar. As it neared the bundle it had to be guided by the hand, so as to bring it down — in bringing it down so they could bring it down square on the tops of the bundles. Then the pressure was put on — whatever pressure was deemed necessary — cords run through them tight, and then were tied at the ends. Whatever little slack there might be there as the pressure was taken — the pressure being taken off, the books would rise, leaving the bundle tightened."

The witness Davis (on page 173), who was a foreman for John F. Busch, bookbinder, and was working in the Tatham building, which was also occupied by John Palmer from 1872 to 1878, says:

"Q. 4. What, if any, means did Mr. Palmer have in his place for pressing and tying up signatures at the time he moved into the Tatham building, and during the time he was occupying rooms in that building?

"A. He had a standing press that worked with an iron bar with two arms on it. They would fill that press with a certain number of sheets, a board on top

and bottom, and tie the ropes around them two ways, and let up the press and take the sheets out.

"Q. 5. Describe the lower platen, upon which the pile of signatures rested, and the upper platen, which was brought down to compress the pile in that press?

"A. I could not do that; I never knew it.

"Q. 6. How did they get the strings around the pile to tie up the bundles?

"A. I never examined the machine at all.

"Q. 7. But you do know that the signatures were put in the press and the platen brought down to compress the pile of signatures, and then strings tied around the pile to hold it compressed when the upper platen was withdrawn, do you not?

"A. I do.

"Q. 8. How recently have you seen that machine?

"A. I have not seen it since they moved out of the building. It was there all the time Mr. Palmer and Mr. Busch occupied the building.

"Q. 9. Do you think you would recognize the machine, or a drawing of it, if you were to see it now?

"A. Well, I think I would.

"Q. 10. I now hand you a sketch, marked 'Exhibit of Palmer Press.' Will you please examine that and state whether it is similar to or differs from the press used by Mr. Palmer at the time when he was in the Tatham building?

"A. Well, the standing of the press, it seems to me, is about as his was, and the mode of screwing down is exactly the same, but the blocks, top and bottom, I could not say anything about.

"Q. 11. Do you know what the purpose of the slots of the top and bottom blocks in a press of this kind were used for?

"A. To put a rope through for tying the bundle. It could not be tied any other way unless the slot was there.

"Q. 12. You saw the press of Mr. Palmer used while he was in the Tatham building, did you not?

"A. I did. We had to pass through his room to go to the elevator; he had a sawing-out machine between our door and this press; nearly every day I had to pass

through there to go to the elevator, and saw a man tying up sheets there, and I would see the boy take the sheets from the press and take them to the sixth floor.

"Q. 13. These were tied up while the bundles were in the press, were they not?

"A. They were.

"Q. 14. And you say that they could not be tied up unless the cross-slots were in the upper and lower blocks. Did you notice, when the bundles were to be removed to be carried to the sixth story, whether these blocks had cross-slots in them or not?

"A. That was my opinion; I did not notice it.

"Q. 15. Have you seen a press for tying up signatures, since the time you moved out of the Tatham building, which had blocks between which the bundles were compressed, which blocks are provided with cross-slots like these in the sketch shown you?

"A. I have not.

"Q. 16. Have you not one in your own establishment, with the same kind of blocks for tying up signatures, which was made under your order?

"A. I have a wooden one, made under my order, which has but one slot — that is crosswise of the sheet — and ties but one way with one rope.

"Q. 17. What suggested the idea to you of making that press with the slotted blocks and single cords for tying up bundles?

"A. I had the idea that we could not tie the rope sufficiently tight unless there was a slot in the block to let it slide through.

"Q. 18. Did you get that idea from the press you saw at the Palmer place, which you say strings were drawn through and tied tightly after the bundles had been compressed?

"A. Never did; never thought anything about his press."

"XQ. 22. For what purpose was the press concerning which you have testified used in the Palmer bindery?

"A. Used for tying up folded sheets."

"XQ. 30. The press in the Palmer bindery was used

merely for bundling gathered books for the purpose of storage, was it not?

"A. I could not say they could bundle gathered sheets as well as books, whether they were all one signature or gathered books, it is all the one thing; I never examined the work that was doing in the press, whether they were bundles of signatures only, or whether they were gathered books."

"RDQ. 33. Can you give a brief description of the manner employed by the workmen who worked on this press in Mr. Palmer's place, to place the sheets in position in the press, tie the bundles and remove the tied bundles from the press?

"A. Well, I can give you a description of the way in which we do it. We take the sheets from the folding machine, count them off in twenty-five, and put six twenty-fives in the press, and then put the pressure on, tie the rope, take the pressure off, and take the bundle out. It is the same way he did them at that time, only they had hand folding; but that was the same principle exactly.

"Q. 34. Were the strings that tied the bundles placed in position for tying before the pressure was put on in both cases?

"A. They are in our case.

"Q. 35. How was it in the Palmer case?

"A. I could not say; I never noticed; I could guess at it; there is one thing certain, they could not put the string on after the pressure is on.

"Q. 36. But you know the bundles were tied in the Palmer press before the pressure was taken off, do you not?

"A. They certainly were, as that is the object of the press — to make a bundle as compact as possible.

"Q. 37. Then, as I understand you, it would be impossible to place the string and tie the bundles unless the top and bottom blocks were grooved, as shown in this sketch? (Palmer press.)

"A. I think it would be.

The testimony of Jones and Robertson, after they knew of the Palmer press, clearly shows that even these experts recog-

nized that the Jones patent was not by any means a pioneer invention, and that the Palmer press and process, as practiced on it, differed in no essential features, involving invention, from the device shown, described and claimed in the Jones patent.

Jones' testimony (page 212):

"XQ. 67. Could the Jones process be practiced on the John Palmer press, a cut of which is shown at page 52 of defendant's record?

"A. Not as this cut shows.

"XQ. 68. Why?

"A. Because the head and back folds of the sheets could not be placed and held in alignment; they would squash out when the pressure is applied.

"XQ. 69. You examined that machine; heard the testimony of the three witnesses, Schrank, McKee and Davis, as to its use for twenty years at the shop of John Palmer and his successor at Philadelphia, which use was described particularly in answer 22, on page 13 of defendant's record, by the witness Schrank. Please read that answer and tell us what step in the Jones process is omitted in the use described in that answer, so far as the fifth claim is concerned, or the use of the Jones press is concerned.

"A. As I said before, that any press which was so constructed that the sheets could be placed all one way, the process could be accomplished, if there were means for the retaining of the pressure, for tying up the bundles, and thereby retaining the pressure by means of the tie, provided rigid end boards were used to distribute the pressure over the entire surface of the bundle. The operation, according to this answer to question 22, varies considerably from that in my process. He says, first, in using it, the strings were laid in the bottom block or platen. In my process the first thing that is done is putting in a rigid end board. Schrank says, 'A piece of paper laid on top of the string, a piece of pasteboard laid on top of the paper.' In my machine the sheets are filled in the trough above the end board. Schrank says the gathered books or signatures piled up in bundles of ten, and a piece of pasteboard on top, and a heavy paper on top again.

The string was then brought over the top of the pile, the top block was then screwed down and the pressure applied. The slack of the string was then taken up, and the bundle tied and removed. In the Jones process, after the sheets are filled into the trough an end board is then placed at the top of the sheets, pressure applied, and the cords passed around the sheets and tied, then removed from the press. The operations dispensed with in the Jones process are the laying of the strings in the bottom block, the placing of a piece of paper, the placing of pasteboard on top, and a heavy piece of paper. These are not done in the Jones. I can't say that, as far as the operation is concerned, I can see any steps that are omitted, as he describes it. There are other parts of his testimony; if I remember correctly, he says the sheets or books were reversed, head and tail. If I am correct, it would not accomplish the process."

The witness evidently dodges a square answer to the questions put to him, pointing out, through his deposition, utterly immaterial differences between his process and the process described by the witnesses who testified as to the Palmer press, which differences are not set out in his patent. The following is an example:

"XQ. 76. The question was why a collection of printed sheets, subjected to pressure in the Palmer press, and while under such pressure tied into bundles with end boards, and then removing them from the press, would not make a compact bundle, while subjecting printed sheets of paper to precisely the same operation in a Jones press would make a compact bundle?"

"A. The Palmer press is incapable of making a compact bundle, by reason that you can not place the sheets in that press in such a way as to make a compact bundle. The only way you could make a bundle of folded sheets in that press was by reversing the sheets in bunches alternately, and the edges would project. Bundles with projecting edges would not, in the sense that I use the term in my process, be compact bundles.

"XQ. 77. You assume that the Palmer sheets or sig-

natures were placed in the press as they came from the folder. Suppose they were subjected to the action of a smasher before they were placed in the press, would the Palmer press then make a compact bundle out of such smashed sheets?

"A. Under those conditions, the sheets being smashed perfectly flat and solid, and the air displaced between the sheets, I think it would be capable to place such sheets in the Palmer press and tie them into bundles; but the pressure would not have been sufficient to keep the pressure so retained for any length of time, especially in large editions, where they have to be stored until the completion of the work. The bundles would become loose by reason of the light pressure which could be exerted by the Palmer press on them before tying. The bundles would fall apart and sheets become scattered over the floor, and many wasted in this way by dust, soiling and crumpling."

It will be seen from this witness' testimony that the only difference he claims between his process, as he understand it (but not set out in his patent), and the Palmer press, is that it would be difficult to get pressure enough on the Palmer press to make bundles as compact as they could be made on the Jones steam-power or hydraulic press. If his assumption be right, it would not aid his patent, either for the process or for the machine, as covered by his claims.

The witness Robertson refers to the Palmer press (page 83) as follows:

"XQ. 38. If the bulk of signatures, after being compressed in the smasher or bulk compressor shown in the Jones patent, were placed between the platens of a vertical press, and the platens brought together, do you think the type indentations would be removed from the signatures if the pressure was left on long enough?

"A. If the platens were brought together with sufficient force, and the pressure retained long enough, I see no reason why the type indentations would not be removed.

"XQ. 39. Well, if the same bundle were put in the Palmer press, and pressure applied and the bundle tied

to retain the pressure, why wouldn't the type indentations be removed if the bundles remained tied long enough?

"A. If sufficient pressure could be produced on the Palmer press, the bundle inclosed in proper end boards, and the bundles tied and kept tied long enough, I believe the type indentations would be removed; but, at the same time, there would most probably be imperfections in the bundle of signatures so pressed, inasmuch as it would be very difficult to keep all the folded edges of the sheets in line, and the result would be that some of the folded edges would overlap the folded edges of the others, and thus the sheets would be imperfectly pressed, although the indentations might possibly be removed if great care were exercised in setting the bundle of signatures in the press."

In answer to XQ. 40, the witness admits the process might be practiced on the Palmer press, but not commercially practical.

"XQ. 41. By 'commercially practical' I suppose you mean that the process carried out on the Palmer press, or on the other presses you have referred to, could not be economically carried out. Am I right?

"A. Generally speaking, that is the way I wish to be understood.

"XQ. 59 (page 87). The Palmer device, as represented by respondent's exhibit 'Sketch of Palmer Press,' is a bookbinder's press and sheet-tie, having compressing heads constructed with cross-ways centrally arranged through them, for the purpose of tying bundles of folded signatures while under pressure, is it not?

"A. Broadly speaking, that is correct, but not in the sense of the first claim of the Jones patent in suit. The claim is to the special 'cross-ways L₂ L₂,' constructed to — as stated in about the middle of the first column of page 1 of the specification, 'afforded access through them to readily insert and manipulate the twine, and to tie the bundles of paper while held compressed, thus

securing the bundle together by a powerful tie.' Such cross-ways are not shown in the Palmer press.

"XQ. 63. Would it require any invention to change the ways in the Palmer press to the shape of the ways shown in the Cooley patent?"

"A. It would not; but even then such ways would not be the equivalents of the cross-ways of the Jones patent.

"XQ. 64. Not even if the circular openings were made large enough to pass the hand and arm of the operator through them?"

"A. If they were made large enough to pass the hand and arm of the operator through them, they would then be the same, practically, as the cross-ways in the Jones patent."

It appears from the above that, if Jones made any invention, it is not disclosed in his specification in the patent in suit, in such clear and exact terms as to enable a mechanic skilled in the art to make and use the same.

It is unintelligible to even the skilled experts called on behalf of complainants. A patent is a contract between the inventor and the public by which the inventor, in consideration of the exclusive use of the invention, secured to him for a limited time, confers upon the public a knowledge of the invention during that period, and an unrestricted right to use it after that period has expired.

The specification is the instrument in which the terms of these mutual considerations and terms are declared, and on its completeness and accuracy depend the validity and the value of the contract itself. Its object is two-fold: First, to place the invention fully within the knowledge of the public; second, to find the exact limits of that exclusive use which the public is advised the patent has undertaken to protect. That is the object and purpose of the specification.

Robinson on Patents, Sec. 481, and cases there cited.

This proposition has been so well settled that it is hardly necessary to cite a great number of authorities in support of it.

The Supreme Court, in *Merrill vs. Yeomans*, 94 U. S., 568,

should be sufficient. The Supreme Court in that case, speaking by Mr. Justice Miller, says:

"A developed and improved condition of the patent law and of the principles which govern the exclusive right conferred by it, leaves no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it without being told what it is that limits these rights. * * * The genius of the inventor constantly making improvements in existing patents, the process which gives to the patent system its greatest value, should not be restrained by vague and indefinite descriptions of claims in existing patents, from the salutary and necessary right of improving on that which has already been invented. It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand and correctly describe just what he has invented, and for what he claims a patent."

In the case at bar the complainants' experts even, and the inventor Jones himself, do not concur as to what Jones invented and disclosed in his patent 204,741.

The inventor Jones, in his testimony already quoted, admits that his actual invention is not disclosed in his specification; that he discovered the omission afterwards; did not reissue his patent when he discovered it, because he was informed that a reissue patent was weaker than the original patent. Acting on this advice he constructed new machines, which embodied his actual invention, to-wit: the steam power press and the hydraulic press, for which he obtained letters patent subsequent to the date of the patent in suit, and among those patents was the one granted for the hydraulic press about which the witnesses, Jones, Suydam, Penicks and others, testified, and which was dated March 4, 1879, No. 212,977; No. 219,734, dated September 16, 1879; No. 223,355, January 6, 1880; No. 224,696, February 17, 1880; No. 227,197, September 27, 1881, and reissue 9598, March, 1881 (see contract, page 96 of the record), and also patent No. 452,898, which was sued upon, which is dated May 26, 1891, the application for which was pending on the 27th day of December, 1889, when the contract between Jones and The W. O.

Hickok Manufacturing Company was executed. Paragraph 5, bill of complaint, page 3 of the record.

The suit, so far as the latter patent is concerned, having been abandoned when complainants' testimony was closed, it can not be considered, but the testimony of all the witnesses on behalf of complainants, in considering the Jones invention, have in mind the later improvements, and the effort of appellees' counsel has been to direct their attention to the Jones invention as disclosed in his later patents, instead of confining their testimony to the patent No. 204,741.

The expert Robertson, in his testimony on prima facie case, gives what he understands to be the invention of Jones at the time he made his application for the patent in suit. On page 37 he considers one improved feature of the Jones invention arranging the sheets in relation to each other, so that the Jones sheets when folded have the *convex impressions* of one-half of the sheet brought in contact with the convex side of the other half of the sheet by the act of folding the sheet in two. He apologizes in the second paragraph of his answer on page 37 for the preceding portion of his answer by stating:

"I have given at some length what I consider the main features of difference between the old and new processes, because in my opinion the process is one that is not easily understood at first, and very few would be likely to understand it unless the essential differences between it and the old processes were pointed out."

Now, it is submitted that, under this statement alone, the specification is vague and uncertain, because there is nothing said in the specification about how the sheets should be folded; in fact, the specification, as the ordinary skilled mechanic would understand it, has nothing to do with the folding, or any step, prior to the printing, drying, folding and smashing. The experts Penicks and Suydam seem to have read the specification and understood it as the expert Robertson understood it, but the inventor Jones does not agree with them.

"XQ. 56 (page 210). Throughout the testimony a good deal has been said about the advantages derived from your supposed invention, from the fact of the type indentations being concaved or convexed, whatever

that may mean. Is there anything said in the patent about that?

"A. No; neither do I claim that they are produced by my process."

They all rely upon the Jones process, as disclosed in his patent in suit, for removing type indentations. There is nothing in the patent about this, nothing in the claims, and Jones himself, in answer to XQ. 57 (page 210), does not claim there is, unless it may be imported into it by the term "dry pressing."

The evidence just quoted bears also on the specification of errors 8 and 10.

It could hardly be expected that even a skilled mechanic would know how to produce a practical operative device from the specification, drawings and claims of the Jones patent which would include the Seybold patented press and sheet-tie, or to construct a machine or device that would accomplish any beneficial result.

Attention has been called before to the fact that there never was a machine, excepting perhaps an experimental wooden machine, made like the drawings of the Jones patent in suit. This was found impracticable and thrown aside, and the Jones hydraulic press, about which all the witnesses have testified, put up in the state bindery at Harrisburg, Pa., before the date of the Jones patent in suit. And, as before stated, this hydraulic machine, and all the improvements put upon it, were covered by subsequent patents not involved in this suit. The auditor, the Supreme Court of the District of Columbia and the Court of Appeals of the District of Columbia all seem to have considered that the Jones invention was the hydraulic press about which Jones and all his witnesses testified throughout the whole of the suit. The testimony of the expert witnesses referred to in the opinion (R., pages 223-231) is as follows:

The witness Suydam, in his direct testimony (Q. 6, page 188), in correcting his answer after adjournment, makes his answer 6 read:

"It was in the fall of 1877 the first machine made and used was at the state bindery, of which I then was foreman."

In his answer to XQ. 49 (page 191), he describes that

machine, and that answer describes the Jones hydraulic press which was in use at the state bindery in the fall of 1877, and was used by Busch after the Seybold machine had been destroyed by fire and Busch had leased or purchased the state bindery.

"XQ. 51. Did you ever see any other kind of machine than the one described in the preceding answer that was said to be made under the Jones patent?

"A. I saw several that were made under the J. W. Jones patent.

"XQ. 52. Were they the same or different from the one you have just described?

"A. Practically the same, except an experimental machine made of wood, which, I believe, led to the invention of the present hydraulic machine."

The expert Robertson, in the concluding part of his answer to direct question 8, on page 40, states:

"I should imagine that the model or press from which the drawing of the Jones press was made had a wooden bed, and was, therefore, more convenient to make it with a slot instead of open spaces shown in the model," etc.

That is exactly what the drawing does show.

The testimony of the expert witness Thomas B. Penicks is much relied upon by the complainants (appellees here), and it appears that he never heard of or knew any other Jones press than the hydraulic press introduced by the witness De Vinne, illustrated between pages 90 and 91 of the record. There are three letters of Mr. Penicks introduced in evidence. The first one, dated February 25, 1879, printed at page 90, commences:

"Your note of the 23d inst., asking my opinion of the advantages and value of J. W. Jones' patent hydraulic printers' and binders' pressing machine is at hand.

"I am pleased to have the opportunity of bearing testimony to the worth of these valuable machines. The three octavo and one quarto machines have been in operation several months." * * *

This brings the sale by Jones to the government printing office back to the fall of 1878.

There is another letter, dated February 5, 1880, printed on the same page of the record, referring again to the hydraulic press, and to nothing else. A third letter of Penicks is printed on page 91, dated August 3, 1886. It states:

"Dear Sir:—The hydraulic pressing machines of J. W. Jones, of Harrisburg, Pa., were introduced in this office in the year 1878."

The testimony of the witness De Vinne is also to the advantages of the use of the Jones hydraulic press.

The absurdity of comparing the savings made by this press and the numerous other presses of Jones, for which he had obtained subsequent patents, is clearly apparent, and particularly in comparing the advantages of the Jones hydraulic press and the Seybold patented press (which were clearly improvements over the Jones hydraulic press, or Seybold could not have obtained his patents) with an old method or process, used fifteen or twenty years before Jones or even Dingman, whose patent was granted October 20, 1863, had improved upon the old processes, instead of comparing the advantages that might be obtained by the use of the Jones invention as disclosed in his patent, by any means which was free to the defendant to use; as, for instance, the Palmer press, the other presses testified to by the witnesses Schrank and Davis prior to the date of the Palmer press, the Dingman patent and the old processes of tying by hand without the use of any press, as testified to by all of complainants' witnesses.

It appears from the record and from the testimony of complainants' witness Miles, chief clerk of The W. O. Hickok Manufacturing Company, that the hand-power press manufactured by The W. O. Hickok Manufacturing Company, printed in front of page 91 of the record, sold for \$350.00. This is an iron machine, iron frame, solid heads like the ones shown in the hydraulic machine and in the Jones steam-power press, and also in patents prior to any invention by Jones, and it is evidently a much stronger and more substantial machine, with these additional improvements upon it, than the duplex machine illustrated

in the Jones patent here in suit; and yet the complainant Jones, in his answer to Q. 88 (page 219), says:

"I question whether his' (Busch's) work could be done on two such hand machines."

It appears from the testimony before the auditor and the auditor's report (Schedule A, page 156), that with the Seybold press sued as an infringement Busch did his work with one machine and with the labor of one boy one-fifth of the time.

When it is taken into consideration again that there was no testimony before the auditor that any profit would have been made had The Hickok Manufacturing Company sold one of their steam-power presses to Busch, instead of his having bought his press from The Seybold Machine Company, there is certainly no basis for even nominal damages.

Jones could be entitled to no damages or profits. He had never received a dollar of royalty for the use of his process, never asked a dollar of royalty, nor is it proven what royalty he received, if any, for the sale of his machines by The W. O. Hickok Manufacturing Company under all his patents at the date of the use of the Seybold machine by Busch.

Jones' testimony (page 218):

"XQ. 82. Had The Hickok Manufacturing Company sold the machine to Mr. Busch instead of The Seybold Machine Company, you would have had no claim against him for damages or profits, would you?"

"A. No."

Assuming that all the witnesses produced by complainants were honest, that the Supreme Court of the District of Columbia and the Court of Appeals for the District of Columbia believed they were, and acted upon the assumption that they were, it is perfectly clear that complainants below (appellees here) so shaped the case and the Jones patent 204,741 that all of these parties believed (and it is fair to assume that they had examined the said patent) that the actual invention of Jones involved in this suit was the Jones hydraulic press and the other features shown in the cuts of the Jones hydraulic press, the Jones steam-power press and the Jones hand press, illustrated in the exhibits introduced in evidence, which were subjects of subsequent appli-

cations and subsequent patents, instead of the Jones patent 204,741 here in suit.

Is there any better evidence that the drawings and specification of the patent here in suit are vague and indefinite, and do not comply with the statute which requires that the invention must be so fully and accurately described that the public and those skilled in the art to which the invention relates may know exactly the limits of patentee's claims?

As before pointed out, it is clear that the Dingman patent discloses everything shown, described and claimed in the Jones patent in suit; and, although the claims may be considered informal, they would be fairly construed, if Dingman was a pioneer (and he certainly was so far as the Jones patent is concerned), to cover the machine and the process disclosed in the Jones patent in suit. The expert Robertson, as before quoted, clearly admits this fact.

Again, looking at the Palmer press and the testimony of the witnesses in relation to it, there is no doubt that if John Palmer had made an application for letters patent for the invention disclosed in the Palmer press and described by the witnesses Schrank, Davis and McKee, that he would have been entitled to cover everything that is shown in the Jones patent here in suit, and not only that, but to include the structure shown in the Jones hand-power press (R., front of page 91), and also the Jones hydraulic and steam-power press introduced between pages 90 and 91 of the record. The expert witnesses Robertson and Hood, and even Jones, do not contradict this proposition.

Looking at the whole case: There is not a new function or result suggested in the Jones patent in suit. There is not a new element in the claims or either of them. There is nothing in this whole case that would not infringe upon the Dingman patent — a patent, if taken out by John Palmer commensurate with the invention disclosed in the Palmer sketch and in the testimony of the witnesses Schrank, McKee and Davis; a machine constructed in accordance with the improved hydraulic press, the hand-power press and the steam-power press of Jones shown in the subsequent patents, the Cooley patent and the Stibbs patent, if these patents were entitled to be construed or reissued to cover what is shown and fairly described in them, regardless of what the state of the art was preceding the date of these very early patents. It is, therefore, clear that Jones could

not be a pioneer, and it is equally clear that he would be an infringer if he used even the hand-power press illustrated in front of page 91, upon each and every one of these patents. Being later than these, the courts can not, by any construction, so broaden the claims of his patent as to include what had preceded the date of his alleged invention.

The Supreme Court has passed upon this question many times, notably in the case of *Ide vs. Ball Engine Co.*, 149 U. S., 550. His Honor Justice Brown correctly states the law in the following language :

"There can be no doubt that if the attachment of the dash pot to the shaft governor had been a novelty at the time his patent was taken out, the Buckeye governor would have been an infringement. This being so, it is equally clear that, existing as it did before his patent, they are an anticipation."

Paraphrasing this language, it is fair to say that there can be no doubt that if the claims of the Jones patent had been a novelty at the time his patent was taken out, the Dingman press, the Palmer press, the Cooley press and the Stibbs press would have been infringements upon his claims. This being so, it is equally clear that, existing as they did before his patent, they are anticipations.

It seems almost needless to cite a great number of authorities in support of appellant's position that, in view of the prior state of the art as disclosed in the record and testified to by complainants' own witnesses, there is no patentable invention disclosed in the Jones patent No. 204,741.

It should be remembered that the invention disclosed in this patent is not an integral machine like the machine of the Dingman patent, like the Palmer press or like the presses testified to as being in public and common use by the witnesses Schrank and Davis even prior to the date that the last Palmer press, from which the sketch was made, was put into use. But it discloses a machine having a smasher or bulk compressor combined with a bundling press, or sheet-tying engine, as Dingman calls it.

A case in point, however, is *Appleton Mfg. Co. vs. Star Mfg. Co.*, 60 Fed. Rep., 411, affirming a decision rendered by His Honor Judge Gresham in 51 Fed. Rep., 285. The patent

in suit in that case was for a corn-husker, and the claims were process claims. It appeared from the testimony that machines had been used for accomplishing practically the same result in analogous branches of the art before they were in use. To adapt these machines to accomplish the result or object attained by the patent in suit in that case, certain mechanical changes were necessary. The court held that these changes, in view of what had been done in analogous branches of the same art, did not require invention. The claim of the complainant below in that case, like here, was that in one organized machine he carried out the processes which had been theretofore carried out by separate machines.

That is what Jones claims here, and what would possibly be true if the suit had been brought upon some of his subsequent patents — even the old hand-power press shown in front of page 91 — but it is not true of the structure shown in the patent. His Honor Judge Gresham in the court below, in commenting upon this case, said:

“The difference between the mechanism described for carrying out the process and defendant’s mechanism is merely structural. It is not true that the patent shows an integral machine. It describes three old and well-known devices — a cutter, a thresher and a separator — mounted on a platform in juxtaposition, and so geared as to operate by a single band wheel, each device operating, however, just as before. They are not combined or incorporated into a single machine, with all its parts co-acting upon a common principle or in obedience to a common law. The steps in the alleged process are the same, whether performed by a cutter, a thresher and a separator mechanically connected, as shown in the patent, or by the same old devices, or their equivalents, having no connection whatever and widely separated.”

In this case, like that, it is not true that the smasher, dry press and sheet-tie are all one integral machine, but are, like the machine in suit in the case cited, at least two old and well-known devices: First, the smasher or bulk compressor to smash and smooth the sheets after they have been printed, dried and folded; and, second, a bundling press to compress the folded

and smashed sheets and tie them while under pressure, precisely as they have been tied in the Dingman press, in the Palmer press; tied by hand as testified to by all the witnesses, and tied as they were in every baling press time out of mind.

The bill was dismissed for want of invention. That decision was affirmed by the Circuit Court of Appeals. The court, in 60 Fed. Rep., 411, in an opinion by His Honor Judge Woods, affirms the decision of the Circuit Court, and the cases referred to by His Honor clearly support the decision and are equally applicable to this case.

A late decision of the Supreme Court of the United States is *Mast, Foos & Co. vs. Stover Mfg. Co.*, 177 U. S., 485—20 Supreme Court Reporter, 708. In that case the patent in suit had been sustained by the Circuit Court and by the Circuit Court of Appeals for the Eighth Circuit, and also by His Honor Judge Grosscup by granting a preliminary injunction in view of these decisions. The case was appealed to the Circuit Court of Appeals for the Seventh Circuit, the preliminary injunction theretofore granted dissolved and the bill dismissed because the device as covered by the claims did not disclose patentable invention, although it was admitted by the court that the same device had never been used in ordinary mills prior to the patentee's adoption of older devices, His Honor Judge Woods stating:

"The first to make such an improvement is not in fact an inventor, and to infer invention merely because it had not been produced sooner, would be to reach a false conclusion by an argument neither presuasive nor plausible."

See *Parlin & Olendorff vs. Moline Plow Co.*, 89 Fed. Rep., 329.

The case was taken to the Supreme Court on writ of certiorari, and the remarks by His Honor Mr. Justice Brown are equally applicable to the case at bar.

An instructive case on this point is *Fuller-Warren Company vs. Michigan Stove Company*, 86 Fed. Rep., 463. This was an appeal from the Circuit Court for the Eastern District of Wisconsin — *Michigan Stove Company vs. Fuller-Warren Company*, 81 Fed. Rep., 376.

In the lower court His Honor Judge Seaman held the pat-

ent infringed, so far as the second and fifth claims were concerned, because the testimony showed that the result attained by the combination was beneficial and had become popular with the trade. The Circuit Court of Appeals, in a decision by His Honor Judge Woods, 86 Fed. Rep., 463, reversed the decree of the Circuit Court for the reasons stated in the last paragraph of the opinion, on page 466. From this ruling a writ of certiorari was taken to the Supreme Court of the United States, and in a brief opinion (172 U. S., 19 Sup. Ct. Rep., 866) the writ of certiorari was denied.

Another instructive case is *Plumb vs. N. Y., N. H. & H. R. Co.*, 97 Fed. Rep., 645. His Honor Judge Townsend, in deciding the case, states the law fully and fairly, and this decision and the cases cited in it seem clearly in point in this case.

Craig et al. vs. Michigan Lubricating Co., 72 Fed. Rep., 173. His Honor Judge Swan dismissed the bill of complaint for substantially the same reasons which defendant here relies upon. This case was appealed to the Circuit Court of Appeals for the Sixth Circuit (81 Fed. Rep., 870), and tried before Judges Taft and Lurton, Circuit Judges, and Judge Sage, District Judge, and in an able opinion by His Honor Judge Sage the decree of the Circuit Court was affirmed.

In *Blakesley Novelty Company vs. Connecticut Webb Company et al.* (78 Fed. Rep., 480), decided by His Honor Judge Townsend, since the decision in *Locomotive Works vs. Medart*, is clearly in favor of appellant's contention in this case, and the decisions cited by His Honor in support of this ruling (on page 481), like all others since the decision in *Risdon vs. The Iron Works*, clearly state the law as contended for by appellant, and are respectfully referred to.

At the hearing of this case before the Supreme Court of the District of Columbia, upon exceptions to the master's report, the auditor supported his findings by reference to *Fenton Metallic Mfg. Co. vs. Office Specialty Co.* The Supreme Court of the District of Columbia affirmed the decision in that case and also the finding of the auditor. Appeal was taken by the defendant — the Office Specialty Mfg. Co. vs. *Fenton Metallic Mfg. Co.* — to this court. The case was heard and reported in 174 U. S., 492, 19 Sup. Ct. Rep., 641. In an able opinion rendered by His Honor Mr. Justice Brown, the case was reversed and a mandate sent down with instructions to order the bill to be dismissed.

King vs. Gallum, 109 U. S., 99. This case seems to be on all fours with the case at bar. The patent is on a baling press, which was for baling plastering hair. The case was brought into the Supreme Court from the decision of the Circuit Court of Appeals for the Seventh Circuit, rendered by His Honor Judge Drummond. The patent upon which the suit was brought was dated June 30, 1874 — more than two years before the application for the patent here in suit was filed. His Honor Judge Drummond dismissed the bill of complaint, holding the patent void for want of patentable invention. The Supreme Court of the United States, in a decision rendered by His Honor Justice Woods, affirmed this decision. The reasoning by His Honor Judge Drummond and the Supreme Court in that case is clearly applicable here.

The auditor, in making his report, was clearly wrong in his comparison of defendant's machine, with all its patented improvements upon it, with the old, ponderous process used many years before the alleged invention of Jones, instead of the profits defendant might have made had he used the old process shown in the Dingman patent, the old Palmer press, the ordinary smasher or bulk compressor and hand-tie, all of which defendant was free to use, and the thing shown in the Jones patent in suit, or had he used in his printing establishment any of the old printing presses he was free to use — the Gordon press, for instance, testified to by the witness Grier, which made no type indentations and obviated the necessity for using fuller boards or the old "ponderous process" so much relied upon by the witnesses on behalf of Jones.

The rule of the Supreme Court is laid down in *Mowry vs. Whitney*, 14 Wall., 651, and *Black vs. Thorn*, 111 U. S., 122, referred to with approval in nearly all the recent cases, notably *Keystone Mfg. Co. vs. Adams*, 151 U. S., 139, and the cases therein cited.

The bill of complaint alleges infringement of two patents; alleges that the two patents, one twelve years later than the one now in suit, were infringed by the single Seybold machine used by Busch, which was the subject of still later patents, and that the inventions described in both of said patents were used conjointly in the same Seybold press.

One of these patents has been dismissed from the suit.

The "agreement" was an exclusive sale of all of the Jones patents to The W. O. Hickok Manufacturing Company, not only

of those mentioned in the agreement, but of all others pending or which Jones might invent relating to the same subject matter, only reserving a specified royalty, which was subject to change at any time on agreement of the parties. There was no proof in the record as to what that royalty was at the time of the complained of infringement. There was no attempt to separate the invention covered by all the claims of the Jones patent now in suit, with all the advantages that were added to it by the subsequent patents, nor any attempt to prove what, if any, profits were due to the complainant Jones for the use of the four claims of the patent in suit.

There is positive proof that the improved form of the Jones patent shown in the hand press would not do the work that Busch was doing—that two of those machines would not do the work. There is proof that if the defendant had bought one of the steam-power presses covered by some of the Jones subsequent patents from The Hickok Manufacturing Company, instead of the one he did purchase in the open market from The Seybold Machine Company, he could have procured it for \$50.00 more than he paid for the Seybold machine, and in that event would not be liable for any damages.

The burden of proof was on the complainants to show the actual profits made by defendant from the use of the invention covered by the patent in suit. As was well said by this court in *Garretson vs. Clark*, 111 U. S., 120, quoting with approval the statement of the rule made in the court below by Judge Blatchford:

“The patentee must in every case give evidence tending to separate or apportion defendant’s profits and the patentee’s damages between the patented feature and the unpatented features, and such evidence must be reliable, tangible, and not conjectural or speculative.”

Until that is done the complainant has not made out a *prima facie* case, and defendant is not called upon to put in any testimony in rebuttal.

Following the rule stated in all the prior cases, and particularly in the cases referred to in 111 U. S., 120, and 151 U. S., 139, only nominal damages should have been awarded, even assuming that defendant had used a combined bulk compressor

and sheet tie like the Jones patent in suit, or the Dingman patent, fifteen years earlier than the Jones alleged invention, to remove type indentations which, in the opinion of all the witnesses called on behalf of complainants, was the invention of Jones, instead of, as the fact is, that his invention had nothing to do with printed folded sheets until they had been printed, dried (if drying was necessary), folded and smashed.

The decree of the lower court, it is submitted, should be reversed at appellee's costs.

GEORGE J. MURRAY,

Counsel for Appellant.

